

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Peter Dam Nielsen et al.
Appl. No.: 09/833,607
Filed: April 13, 2001
For: RADIO TERMINAL

Confirmation No.: 3735
Group Art Unit: 2173
Examiner: Pillai, Namitha

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Commissioner for Patents
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REPLY BRIEF UNDER 37 CFR § 1.193(b)(1)

This Reply Brief is filed in response to the Examiner's Answer mailed on January 9, 2008, the Examiner's Answer being in response to an Appeal Brief filed October 15, 2007. This Reply Brief addresses various points raised by the Examiner's Answer.

7. *Argument.*

As explained in the Appeal Brief at pages 5-11, claims 10-30 are patentably distinct from the cited reference. Accordingly, Appellants respectfully request that the aforementioned rejections be reversed.

In reply to the Examiner's Answer, Appellants again submit that the cited reference fails to teach or suggest the recited features of the claimed invention. The Examiner's Answer is, in large part, simply a repeat of the same recitations used in the final Office Action in rejecting the currently pending claims. As such, Appellants respectfully submit that since the Appeal Brief pointed out the flaws in the Examiner's reasoning with respect to these rejections, no further discussion of the issues previously addressed need be presented herein. Rather, Appellants will direct the comments presented herein toward responding to the specific assertions from the "Response to Argument" section of the Examiner's Answer (pages 8-13).

10. ***Response to Argument.***

The Examiner's Answer identified three of Appellants' arguments of section 7 of the Appeal Brief and provided responses to three of these arguments presented by the Appeal Brief. These three arguments were labeled under the section headings B, C and D in the Appeal Brief and are labeled accordingly herein for the sake of consistency.

B. Schwartz fails to teach or suggest elements of the independent claims of the claimed invention.

In pages 5-7 of the Appeal Brief, Appellants argued that Schwartz fails to teach or suggest all the features of the claimed invention. In response to this argument, pages 8-11 of the Examiner's Answer assert that "Schwartz has clearly disclosed displaying a menu structure with a continuous length item and a wrapped length item" (see page 10 of the Examiner's Answer). The Examiner's Answer then asserts that "Schwartz does disclose a displayable menu structure with items that can be selected" and that these items "include selectable continuous length item and wrapped length item" (see page 10 of the Examiner's Answer). Finally, the Examiner's Answer concludes that "providing these length items as display options would have been obvious."

Appellants respectfully submit that the first and last of these statements quoted above is incorrect and therefore, the claimed invention is not obvious in view of Schwartz. As an initial matter, Appellants submit that Schwartz does not disclose displaying a menu structure with a continuous length item and a wrapped length item. In this regard, it should be noted that for the Examiner's assertion to be correct, Schwartz must do both of 1) disclose both a continuous length item and a wrapped length item and 2) disclose that such items are within a menu structure. However, this is not the case at least because Schwartz never discloses a menu structure that includes providing a displayed menu structure having a selectable continuous length item and a wrapped length item as display options, wherein selection of either corresponding option causes elements to be accordingly displayed as generally set forth by the independent claims of the claimed invention.

First of all, the assertion that "Schwartz has clearly disclosed displaying a menu structure with a continuous length item and a wrapped length item" at page 10 of the Examiner's Answer

is directly contrary to the admission of page 3 of the final Office Action, which admits that “Schwartz does not disclose providing display menu options for the user to choose one of continuous length item option or wrapped length item option”. Second, and more importantly, Schwartz discloses a dynamic screen display effect that is not even selected by a menu option as provided in the claimed invention. Rather, the only mention of menu items in Schwartz relates to the fact that items in a menu may be modified so they are displayed consistent with the goals of Schwartz (col. 2, lines 38-42). Thus, while Schwartz relates to impacting the way items that may be viewed in a menu format are displayed, Schwartz never teaches or suggests presenting selectable menu items for impacting the way items that may be viewed in a menu format are displayed. As such, Schwartz does not disclose displaying a menu structure with a continuous length item and a wrapped length item.

With regard to the Examiner’s second assertion that “Schwartz does disclose a displayable menu structure with items that can be selected”, Appellants respectfully note that the menu structure displayed in Schwartz merely illustrates alternative solutions for displaying text which exceeds the width of a display. Thus, the items in the menu structure of Schwartz, whether selectable or not, merely show items in the abstract and do not show items that “include selectable continuous length item and wrapped length item” as asserted at page 10 of the Examiner’s Answer. As stated above, Schwartz never discloses providing a displayed menu structure having a selectable continuous length item and a wrapped length item as display options, wherein selection of either corresponding option causes elements to be accordingly displayed as generally set forth by the independent claims of the claimed invention. Schwartz does not describe any displayable item that can be selected to impact how elements are displayed.

In this regard, it should be noted that the claimed invention generally provides items in a menu structure that, when selected, cause elements to be displayed as continuous length elements or wrapped length elements dependent upon which respective item is selected. Meanwhile, at best, Schwartz discloses a continuous length element and a wrapped length element. However, selection of either of these elements of Schwartz is in no way taught or suggested to cause the display of anything in a respective format. Thus, even if one assumes that Schwartz discloses an exemplary continuous length element in one location and an exemplary wrapped length element in another, such elements are not presented in a display menu structure so that selection of the

continuous length item causes the element to be displayed as the continuous length element on a single line of the mobile terminal display and selection of the wrapped length item causes the wrapped length element to be displayed on a plurality of lines of the mobile terminal display as provided in the claimed invention.

Although the statements above from the Examiner's Answer have been shown to be incorrect, the Examiner's Answer includes other statements to support the current rejections. For example, the Examiner's Answer also asserts (see page 10 of the Examiner's Answer) that Schwartz discloses continuous and wrapped length items as two separate display formats and that it would be obvious to one of ordinary skill in the art to provide these options as display options in a menu. The Examiner's Answer also asserts that toggling between menu options is well known in the art and thus it would be obvious to modify Schwartz to provide this capability as well.

Appellants respectfully disagree with these assertions and submit that not only does Schwartz fail to teach or suggest the features of the claimed invention, but the disclosure of Schwartz teaches away from the features of the claimed invention as provided below in part D and in the Appeal Brief at pages 9 and 10. Thus, given that the disclosure of Schwartz fails to teach or suggest the features of the claimed invention, and that the disclosure and express purpose of Schwartz would render no benefit to one of skill in the art, and in fact defeat the purpose for employing the claimed invention (see part D below), it would not be obvious to one of skill in the art to modify Schwartz to achieve the claimed invention.

C. The final Office Action failed to provide a *prima facie* case with respect to obviousness.

As indicated at pages 7-9 of the Appeal Brief, the final Office Action failed to provide a *prima facie* case with respect to obviousness since the Examiner tried to take a shortcut of merely stating that "the obviousness of providing the wrapped length display of text and continuous display of text as options in the menu of user options would have been obvious" (see page 10 of the final Office Action). In the Examiner's Answer, the Examiner has tried to cure this deficiency by providing a clearer explanation of the rejection as being made in view of what one of skill in the art knows about providing display options for the user to toggle. Notably, the

Examiner provided further evidence of what one of skill in the art would know in this regard by referring to the Windows 3.0 disclosure.

As an initial matter, Appellants respectfully submit that a *prima facie* case of obviousness was not made in the final Office Action as evidenced, at least in part, by the strenuous efforts to cure this deficiency finally in the Examiner's Answer. Furthermore, Appellants submit that it is not equitable for the Examiner to be permitted in any case to delay making a *prima facie* case of obviousness until after an application has moved to appeal. As such, the use of additional evidence to remedy a previously defective rejection with respect to *prima facie* obviousness represents a new ground of rejection even if couched in terms of evidence defining the level of skill in the art. Despite this new ground of rejection, Appellants maintain the present appeal.

D. Schwartz teaches away from the claimed invention.

Appellants asserted at pages 9 and 10 of the Appeal Brief that Schwartz teaches away from the claimed invention. The Examiner's Answer appears to merely repeat previous lines of reasoning in responding to Appellants assertion. As such, the Examiner's Answer does not refute Appellants arguments on this issue. Thus, since the entire purpose of Schwartz is to display portions of elements that are too long with at least portions of other elements that may be short enough to display at the same time, there would be no need to toggle between different display options, since Schwartz aims to provide an ability to "see as many of the elements as possible at once" (col. 3, lines 12-13). Such an "optimized" view would not be suggestive of any need to provide toggling between views. Moreover, the view provided by Schwartz would aim to provide for both continuous and wrapped length items to be simultaneously displayed (see FIG. 7) since some elements could be seen in their entirety while others would have portions continuing beyond the screen display with available scrolling, so there would be no reason to provide toggling between display options in this regard in any case.

Thus, one of skill in the art would, in fact, not only not be motivated to modify Schwartz to place such options as are provided in the claimed invention into a menu structure, but such a modification would be completely purposeless in light of Schwartz.

CONCLUSION

For at least the foregoing reasons, as well as those presented in the Appeal Brief, Appellants respectfully request that the rejections be reversed.

Respectfully submitted,



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